

REMARKS / ARGUMENTS

I. General Remarks and Disposition of the Claims.

Please reconsider the application in view of the following remarks. The remarks and arguments submitted in the previously filed Response to Final Office mailed February 16, 2005 (filed April 15, 2005), are incorporated in this Response by reference.

In this Response, claims 1-3, 5-18, and 60-62 are pending. Claim 1 is currently amended. Claim 4 was previously cancelled. Claim 5 was previously presented. Claims 19-59 were previously cancelled in response to a restriction requirement. Claims 60-62 are new.

II. Claims 1-3, 6-7, and 17 Are Not Anticipated by *Scepanski*.

The Examiner has withdrawn the rejections of claims 1-3, 6-7, and 17 as being anticipated by *Scepanski*, U.S. Patent No. 6,028,113. (Advisory Action at 2.) The Applicants herein acknowledge the Examiner's withdrawal of this rejection.

III. Claims 1-3, 5-13, and 17 Are Not Anticipated by *Houghton*.

Claims 1-3, 5-13, and 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by *Houghton*, European Patent Application No. 0510762A2. (Office Action at 2.) Applicants respectfully traverse.

With respect to *Houghton*, the Examiner has stated:

Houghton teaches inorganic per salt such as sodium perborate. On page 9, *Houghton* teaches the sodium perborate as an anhydrous solid which is blended with the liquid phase. The limitations of a degradable particle is an inherent characteristic of the composition since *Houghton* and the instant application are claiming the same composition.

(Advisory Action at 2.)

To anticipate Applicants' invention, *Houghton* must teach every element of the invention. Manual of Patent Examining Procedure § 2131 (8th ed., rev. 2, May 2004) (hereinafter "MPEP"). Applicants respectfully submit that *Houghton* does not teach every element recited in claims 1-3, 5-13, and 17.

Houghton does not teach methods comprising "a cleaning fluid comprising . . . degradable particles . . . wherein the degradable particles have an average particle size greater

than 300 μm ” as recited in amended independent claim 1. Rather, *Houghton* teaches particulates with a “weight average particle size of less than 300 microns.” (*Houghton* at 6, l. 14.) Nowhere does *Houghton* teach or suggest particles having an average particle size greater than 300 μm , as required by claim 1 as amended.

Therefore, Applicants respectfully assert that claim 1 is not anticipated by *Houghton* because *Houghton* does not teach every element of the invention as required by MPEP § 2131. Claims 2-3, 5-13, and 17 depend either directly or indirectly from independent claim 1. All these dependent claims, which include all the limitations of claim 1, are allowable for at least the reasons cited above with respect to independent claim 1. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-3, 5-13, and 17 and further request the timely issuance of a Notice of Allowance for these claims.

IV. Claims 1, 8, and 15-16 Are Not Anticipated by *Banerjee*.

Claims 1, 8, and 15-16 stand rejected under 35 U.S.C. 102(e) as being anticipated by *Banerjee*, United States PG Pub. No. 2003/0188766 A1. (Office Action at 3.) Applicants respectfully traverse.

With respect to *Banerjee*, the Examiner has stated:

Applicant’s arguments are unpersuasive since a fluid by definition encompasses both liquid and gases and therefore the claim limitations read on the teachings of the reference. Additionally, col. 3, claim 12 teaches spraying liquid CO₂ and particles simultaneously.

(Advisory Action at 2.)

To anticipate Applicants’ invention, *Banerjee* must teach every element of the invention. MPEP § 2131. Applicants respectfully submit that *Banerjee* does not teach every element recited in claims 1, 8, and 15-16 as amended.

Banerjee does not teach methods comprising “a cleaning fluid comprising a liquid base fluid and degradable particles . . . wherein the degradable particles have a weight average particle size greater than 300 μm ” as recited in amended independent claim 1. Rather, *Banerjee* teaches the use of “solid CO₂ snow particles” (*Banerjee* at 2, ¶ 21) that “are less than about 0.76 μm in size” (*Banerjee* at 4, claim 19). Nowhere does *Banerjee* teach or suggest particles having a weight average particle size greater than 300 μm , as required by claim 1 as amended.

Therefore, Applicants respectfully assert that claim 1 is not anticipated by *Banerjee* because *Banerjee* does not teach every element of the invention as required by the MPEP § 2131. Claims 8 and 15-16 depend either directly or indirectly from independent claim 1. All these dependent claims, which include all the limitations of claim 1, are allowable for at least the reasons cited above with respect to independent claim 1. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1, 8, and 15-16 and further request the timely issuance of a Notice of Allowance for these claims.

V. Claims 1-3, 5, 14, and 18 Are Not Obvious Over *MacVitte*.

Claims 1-3, 5, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *MacVitte*, U.S. Patent No. 3,272,650. (Office Action at 4.) Applicants respectfully traverse.

With respect to *MacVitte*, the Examiner has stated:

Applicant's arguments are not persuasive since applicant is not claiming the specific base fluid. Additionally, on[e] would reasonably expect the particle to degrade as a result of turbulent flow through the conduit during cleaning. Additionally, degradation is not limited to dissolution of particles in water. Degradation can result based on other means, as previously discussed in the specification and the previous Office Action. However, *MacVitte* does not teach away from degradation of the particle by other means such as impact of the conduit during cleaning and applicant has not limited the definition of degradation of particles to solely include dissolution with water.

(Advisory Action at 2.)

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-3, 5, 14, and 18, in that *Macvitte* does not teach or suggest each and every claim limitation and there is no suggestion or motivation to modify *Macvitte* as suggested by the Examiner. See MPEP § 2143.

A. *MacVitte* Does Not Teach or Suggest Every Element of Claims 1-3, 5, 14, and 18.

A *prima facie* case of obviousness requires a showing that *MacVitte* teaches or suggests all the limitations of claim 1. MPEP § 2143.03. Applicants respectfully submit that the

Examiner has not established a *prima facie* case of obviousness because *Macvitte* does not teach or suggest all the limitations of claim 1.

In particular, *MacVitte* does not teach or suggest methods comprising “a cleaning fluid comprising . . . degradable particles” as recited in independent claim 1. Instead, *MacVitte* teaches using “a suspension of irregular shaped particles of an inert organic material, such as resins or plastics.” (*MacVitte* col. 1, ll. 36-38.) *MacVitte* also teaches that “the liquid must not react with or dissolve the suspended particles.” (*MacVitte* col. 2, ll. 4-5.) As such, *MacVitte* does not teach or suggest that these particles are degradable, nor does *MacVitte* teach or suggest any conditions in which these particles could degrade. Thus, *MacVitte* does not teach or suggest each element of Applicants’ invention and consequently cannot be used to form the basis of a *prima facie* case of obviousness.

B. *MacVitte* Does Not Suggest or Motivate the Specific Modification of Elements Claimed by Applicants in Claims 1-3, 5, 14, and 18.

A *prima facie* case of obviousness requires a suggestion or motivation in the prior art references to make the specific modification of elements claimed by Applicants. MPEP § 2143.01. And even the fact that references can be modified does not render the resultant modification obvious unless the prior art teaches or suggests the desirability of the modification, which *MacVitte* fails to do. M.P.E.P § 2143.01.

The Examiner assumes that one “would reasonably expect the particle to degrade as a result of turbulent flow through the conduit during cleaning,” and that “*MacVitte* does not teach away from degradation of the particle by other means such as impact of the conduit during cleaning.” (Advisory Action at 2). In fact, *MacVitte* suggests the opposite. From *MacVitte* one would not expect the particle to degrade, and *MacVitte* teaches away from particle degradation. First, *MacVitte* teaches that the particle should be inert and should not degrade in the suspending liquid. (*MacVitte* col. 1, ll. 44-46, col. 2, ll. 4-5.) Second, *MacVitte* provides two examples in which resin particles suspended in water are passed through a conduit without degradation. (*MacVitte* col. 3.) In both examples, the particles were recycled through the conduit, and at the end of the operation, the particles were separated from the liquid for reuse. (*MacVitte* col. 3, ll. 22-26, col. 3, ll. 44-45.) If the particles degraded as the examiner suggests, such recycling and separation would not be reasonably feasible. Nowhere does *MacVitte* teach or suggest a modification to use degradable particles. Thus, *MacVitte* does not teach or suggest each element

of Applicants' invention and consequently cannot be used to form the basis of a *prima facie* case of obviousness.

Further, as provided in MPEP § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a *prima facie* case of obviousness. To the extent that Examiner relies on such a statement or statements to supply the necessary motivation to modify *MacVitte*, Applicants hereby respectfully traverse the lack of such a showing, and request under MPEP § 2144.03(C) that the Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the specific modification of elements to arrive at Applicants' invention.


Therefore, Applicants respectfully assert that claim 1 is not novel and nonobvious over *MacVitte* because the Examiner has failed to establish a *prima facie* case of obviousness as required by MPEP § 2142. Claims 2-3, 5, 14, and 18 depend either directly or indirectly from independent claim 1. All these dependent claims, which include all the limitations of claim 1, are allowable for at least the reasons cited above with respect to independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a) with respect to claims 1-3, 5, 14, and 18, and further request the timely issuance of a Notice of Allowance for these claims.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no additional fees due in association with this filing of this Amendment and Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Halliburton Energy Services, Inc. Deposit Account No. 08-0300.

Respectfully submitted,

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